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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,616	07/11/2006	Kazuaki Nakamura	02860.1073	8531
22852	7590	07/08/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER ENG, ELIZABETH	
			ART UNIT	PAPER NUMBER
			1796	
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			07/08/2009 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/585,616

**Applicant(s)**

NAKAMURA ET AL.

**Examiner**

ELIZABETH ENG

**Art Unit**

4151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Claim Objection**

1. Claim 18 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 17. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### **Election/Restrictions**

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claims 1, 13-18, and 29-31, drawn to an optical resin lens and a production method utilizing a catalyst comprising a titanium halide and an organic aluminum, wherein claims 17 and 18 are duplicates of each other.

Group 2, claims 2, 13-16, and 29-31, drawn to an optical resin lens utilizing a catalyst comprising titanium halide and an organic aluminum and a process that hydrogenates the polyolefin.

Group 3, claims 3, 13-16, 19, and 29-31, drawn to an optical resin lens and a production method utilizing a catalyst comprising a solid powder A) comprising a reduced titanium halide, one of the formulas (I)-(III), an organic aluminum compound, and B) an organic aluminum compound.

Group 4, claims 4, 13-16, 20, and 29-31 drawn to an optical resin lens and a production method that are the same as claims 3 and 19, but with a final hydrogenation step.

Group 5, claims 5, 13-16, 21, and 29-31, drawn to an optical resin lens and a production method utilizing a catalyst comprising an organic aluminum compound, a reaction product of magnesium and titanium halide, and a Lewis base.

Group 6, claims 6, 13-16, 22, and 29-31, drawn to an optical resin lens and a production method that are the same as claims 5 and 21, but with a final hydrogenation step.

Group 7, claims 7, 13-16, 23, and 29-31, drawn to an optical resin lens and a production method utilizing a catalyst system comprising A) a titanium-incorporating catalyst

comprising a) an organic magnesium compound b) a halide c) titanium halide, and B) an organic aluminum.

Group 8, claims 8, 13-16, 24, and 29-31, drawn to an optical resin lens and a production method that are the same as claims 7 and 23, but with a final hydrogenation step.

Group 9, claims 9, 13-16, 25, and 29-31 drawn to an optical resin lens and a production method utilizing a catalyst system comprising A) a titanium-incorporating solid catalyst comprising a) silanol b) a magnesium compound c) a titanium halide d) an electron-donating compound, and B) and organic aluminum.

Group 10, claims 10, 13-16, 26, and 29-31, drawn to an optical resin lens and a production method that are the same as claims 9 and 25, but with a final hydrogenation step.

Group 11, claims 11, 13-16, 27, and 29-31, drawn to an optical resin lens and a production method utilizing a catalyst system comprising A) a titanium-incorporating solid catalyst comprising a) silanol b) Grignard c) titanium halide d) electron-donating compound, and B) an organic aluminum.

Group 12, claims 12, 13-16, 28, and 29-31, drawn to an optical resin lens and a production method that are the same as claims 11 and 27 but with a final hydrogenation step.

3. The inventions listed as Groups 1-12 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Each group is drawn to an optical resin lens and a process of making the lens from polyolefin. However, the groups do not share a corresponding special technical feature. Specifically, each group utilizes a different catalyst, making the resulting products of each group chemically distinct from each other. Furthermore, a hydrogenated polyolefin is chemically distinct from a nonhydrogenated polyolefin.

4. A telephone call was made to the attorney Ernest Chapman on 6/15/2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

5. The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does

not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the

above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH ENG whose telephone number is (571)270-7743. The examiner can normally be reached on M-R, 8:30am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EE

/David Wu/  
Supervisory Patent Examiner, Art Unit 1796